

O-113-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2596750  
BY  
TREATTICKET LIMITED  
TO REGISTER THE TRADE MARK**

The logo for TreatTicket, featuring the word "Treat" in a dark red font and "Ticket" in a green font, both enclosed within large, stylized red curly braces.

**IN CLASS 35 AND 38**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 103598  
BY  
O2 HOLDINGS LIMITED**

## Background and pleadings

1. Treatticket Limited (“the applicant”) applied for the following trade mark on 1 October 2011:



2. The application was published in the *Trade Marks Journal* on 20 April 2012, following which it was opposed by O2 Holdings Limited (“the opponent”).

3. The following services are applied for, all of which are opposed:

*Class 35: Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, and discount information.*

*Class 38: Providing links to the retail websites of others.*

4. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), which states:

“(2) A trade mark shall not be registered if because –

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

5. The opponent bases this ground upon its earlier registered Community trade mark (“CTM”) 9512732, TREATS, registered in classes 9, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45. This mark completed its registration procedure on 26 April 2011. The opponent’s notice of opposition<sup>1</sup> states that all the goods and services are relied upon to oppose all of the applicant’s services. The lengthy specifications are set out as an annex to this decision. The opponent claims that the identity or similarity between the parties’ goods and services, combined with

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<sup>1</sup> Form TM7

the claimed similarity between the marks, will lead to a likelihood of confusion. The opponent singles out the claimed similarity between the parties' services in classes 35 and 38.

6. The applicant filed a counterstatement in which it states that it is not aware of any instances of the public confusing the parties' marks for one another. The applicant states that its mark contains more than twice the number of letters, includes an additional word (ticket), and that the marks are visually and phonetically different. It claims that the opponent's mark does not possess a highly distinctive character because it is a common word. The applicant states "therefore the likelihood of confusion on the part of the public is low", but also states that its mark is not similar enough to the opponent's mark to cause confusion on the part of the public. I will take this as a denial of a likelihood of confusion.

7. Neither side filed evidence. The applicant filed brief written submissions during the evidence rounds. The parties were given a choice as to whether they wished to be heard or for the decision to be made from the papers, without a hearing. The opponent filed written submissions in lieu of attending a hearing. Both sides indicated that they were content for a decision to be made from the papers.

## **Decision**

8. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union („CJEU"): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

## Comparison of goods and services

9. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

10. „Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

12. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

13. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the

category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14. The applicant's written submissions<sup>2</sup> are reproduced below:

"1. The Applicant submits that its mark and the Opponent's mark do not relate to the same or similar services as stated in the Opponent's notice of opposition.

2. The Applicant's mark relates to the sale of vouchers for discounted products/services of third party retailers by way of a group buying scheme. The vouchers are sold to the Applicant's customers who then redeem the vouchers with third party retailers in return for the discounted products/services.

3. The Opponent's mark relates to a customer loyalty or reward scheme operated by the Opponent. The rewards offered are discounted or free products/services of the Opponent."

The earlier mark is not subject to the proof of use of provisions because it had been registered for less than five years at the date on which the application was published<sup>3</sup>. This means that the goods and services for which the opponent's mark is registered must be considered upon the basis of notional and fair use for the full range of goods and services for which it is registered, not in relation to those on which the mark has (allegedly) been used. In *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch), Arnold J said:

"76. It is common ground that it is now clear that there is an important difference between the comparison of marks in the registration context and the comparison of mark and sign in the infringement context, namely that the former requires consideration of notional fair use of the mark applied for, while the latter requires consideration of the use that has actually been made of the sign in context."

As these proceedings are concerned with an opposition to an application to register a trade mark, rather than infringement proceedings, it is notional and fair use across both parties' specifications which must be the basis for the assessment, and not the use made by the parties of their marks. Section 5(2)(b)

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<sup>2</sup> The submissions consist more of unsupported factual assertions than submissions, but the contents do not affect the outcome of the decision.

<sup>3</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

is concerned with whether there is a likelihood of confusion, not what has actually happened. I have to consider what is in the specifications entered on the statutory application form.

15. In its notice of opposition, the opponent relies upon lengthy specifications in eleven classes. In its statement of case, the opponent states that the parties' services in classes 35 and 38 are identical or very similar. Beyond this claim, the opponent has not given any indication as to where it considers similarity to lie between the applicant's services in classes 35 and 38 and its own goods and services in classes 9, 36, 37, 39, 41, 42, 43, 44 and 45. The opponent confines its written submissions (relating to similarity between the goods and services of the parties) to a comparison between the parties' services in classes 35 and 38. I shall take this as my starting point.

16.

<b>Opponent's services</b>	<b>Applicant's services</b>
<p>Class 35:</p> <p>Advertising; business management; business administration; office functions; retail services and online retail services relating to scientific, nautical, surveying, photographic, cinematographic, optical weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire extinguishing apparatus, apparatus for the transmission of sound or image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer</p>	<p>Class 35:</p> <p>Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, and discount information.</p>

<p>software, computer software downloadable from the Internet, PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, computer software recorded onto CD-Rom, SD-Cards, glasses, spectacle glasses, sunglasses, protective glasses and cases therefor, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, mobile telephone covers, mobile telephone cases, magnetic cards, encoded cards; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.</p>	
<p>Class 38: Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; broadcasting</p>	<p>Class 38: Providing links to the retail websites of others.</p>

<p>services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database, providing access to computer databases, rental of access time to a computer database; operation of a network, being telecommunication services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.</p>	
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17. The opponent's specifications include broad terms. Services can be considered as identical when the services of the earlier mark are included in a more general category, included in the trade mark application; as per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05. Also, if the services of the application are included in a general category of the services of the earlier mark, they must be identical. In relation to class 35 and its *advertising* services, the opponent contends that this covers the services in class 35 of the application. The applicant's services are a way of "promoting the goods and services of others", the means being by providing a website featuring coupons etc. The opponent's service is advertising; advertising is the promotion of goods and services of, or for, others. The applicant's service, being the promotion of goods and services of others, is identical to the opponent's advertising service. The applicant's services in class 35 are **identical** to the opponent's *advertising*.

18. The opponent contends that its *telecommunications, internet portal services* and *providing access to computer databases* services are identical to the

applicant's *providing links to the retail websites of others*. The nature and purpose of the applicant's service is to enable the retailer to come to the potential customer's attention and to enable the customer to „click through' to the third-party website. The nature of telecommunications services is the means of conveying of information (sound and images) and the purpose is to convey information. Internet portal services are telecommunication gates to enable access to the internet. Providing access to computer databases is a telecommunications service for connection to a database. There would not be a sharing of trade channels, the services are not in competition and are not complementary (the telecommunications service is not reliant upon the provision of links to retail websites); telecommunications are used to facilitate a multitude of transactions, as are computer programmes, but this does not make them complementary to the service ultimately provided. There is no similarity between the opponent's services in class 38 and the applicant's services in class 38.

19. However, a comparison between the applicant's services in class 38 and the opponent's services in class 35 reveals some similarities. The applicant's service enables the retailer to come to the potential customer's attention and enables the customer to „click through' to a third-party website. The nature and purpose is very close to online advertising (which is the promotion of goods and services of, or for, others). The retailer may choose this form of promotion or a more conventional form of advertising, and the same service provider may provide both the applicant's service and the opponent's service of advertising. They are, therefore, in competition. The applicant's services in class 38 are **highly similar** to the opponent's advertising.

20. The opponent relies upon the full list of goods and services of its CTM. It appears to have identified its best case as being a comparison between the parties' services in classes 35 and 38. The opponent has not provided any indication as to where it considers similarity to lie in respect of its lengthy specifications in the other nine classes, and it is not obvious to me that there is similarity. I have limited my comparison to those services which the opponent has itself identified and which appear to present the opponent with its best case. If it is not successful in demonstrating a likelihood of confusion in respect to these services, it will not succeed in respect of its other goods and services. Consequently, I do not need to go any further in my comparison of the parties' goods and services.

#### Average consumer and the purchasing process

21. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. For the applicant's services, the average consumer is the retailer who requires its goods and services and its retail website to be promoted and visited. The average consumer for the opponent's advertising services will be any business which requires its goods or services to

be promoted. The purchasing process is liable to be more visual than aural as selection will be on the basis of brochures and website information. The average consumer will pay a good deal of attention to the purchasing process as it will hope that the success of its business will be improved as a result of the use of the service. The nature of the services and the nature of the user of the services will lessen the effects of imperfect recollection.

Comparison of trade marks

22. The marks to be compared are:

Opponent's mark	Applicant's mark
TREATS	

23. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components.”

There is only one component in the opponent's word only mark, TREATS; this is the dominant and distinctive component of the word-only mark. The applicant's mark consists of the conjoined words TREAT and TICKET. They will be perceived by the average consumer as two words because of the use of upper and lower case letters and because they are two very common words which will be picked out. Nothing turns upon the colour aspect of the application because neither mark is limited to colour<sup>4</sup>. Neither word in the applicant's mark is dominant over the other; Treat „describes' Ticket and, together, the two words form an indissoluble<sup>5</sup> whole. The bracket-shaped device elements contribute to

<sup>4</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

<sup>5</sup> See the General Court in *Ella Valley Vineyards (Adulam) Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) T-32/10.

the overall impression of the mark, but it is the words which are the dominant distinctive component.

24. Treat „describes’ Ticket because the conceptual message of the application is that it is a ticket for a treat; i.e. the ticket gains access to the treat. Its position as the first word of the mark turns its presence into a description of the ticket. The device elements are evocative of a ticket and reinforce the overall conceptual message of a ticket for a treat. In the opponent’s mark, Treats is a noun. The conceptual message of the opponent’s mark is treats *per se*. The concepts of the two marks are therefore not identical because the one conveys the idea of a ticket for a treat and the other simply a plurality of treats, but there is a moderate amount of conceptual similarity because of the common „treat’ component. There is a moderate degree of visual and aural similarity; the common element appears at the beginning of the applicant’s mark, but the second word element is prominent and longer in length than the common element. Added to that, from a visual point of view, the brackets are evocative of a ticket and these are absent from the opponent’s mark. Overall, there is no more than a moderate level of similarity between the marks.

#### Distinctiveness of the earlier mark

25. It is necessary to consider the distinctive character of the opponent’s mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion<sup>6</sup>. The opponent has not filed evidence of use<sup>7</sup>, so there is only the inherent distinctive character position to consider. The applicant claims (in its counterstatement) that the opponent’s mark does not have a highly distinctive character because it is a common word. This proposition is contrary to law: it is well established that the distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public<sup>8</sup>. The example given by the opponent illustrates the point: APPLE is distinctive for goods in class 9 but it is also a common word. What matters is the relevant public’s perception of TREATS for the goods and services for which it is registered; in particular, for *advertising* services which I have found to be identical to and highly similar to the various services covered by the application.

26. Collins English Dictionary (2000 edition) gives the definition of a treat as:

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<sup>6</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>7</sup> Although the opponent included promotional figures in its written submissions filed in lieu of a hearing, I have not taken them into account because they were not filed as evidence.

<sup>8</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

“noun

1. a celebration, entertainment, gift, or feast given for or to someone and paid for by another.
2. any delightful surprise or specially pleasant occasion.”

Treats is neither descriptive of nor allusive to advertising services. The goods or services that are advertised may be a treat but that cannot be conflated with the service of advertising. Treats has a reasonable degree of inherent distinctiveness.

#### Likelihood of confusion

27. The applicant states that it is unaware of any instances of confusion between the parties' marks. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. There must be evidence to suggest that the relevant public has shown that it distinguishes between the parties' services. As neither party has filed evidence as to what use it has made of its mark, it is not possible to take this argument any further.

28. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I found that the parties' services are identical and highly similar. However it is not an automatic sequitur that because goods/services are identical or highly similar that the trade marks have to be very different to avoid finding a likelihood of confusion<sup>9</sup> Trade marks must be considered in their entireties, taking into account the dominant and distinctive components, because the average consumer perceives trade marks as wholes. The average consumer rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. In view of the differences between the marks, it is unlikely that the marks will be imperfectly recalled as one another. The marks will be primarily visually perceived and the device, creating a ticket impression, will not be lost on the average consumer. Even though there is a rough rule of thumb that beginnings of marks are more important and here the common element, TREAT(S) is at the beginning of the applicant's mark, it is no more than a rule of thumb which is tempered, for example, when the component is descriptive or is a common combining form, when the importance may be reduced<sup>10</sup>. The GC said, in *Citigroup, Inc v OHIM* Case T-325/04, when considering the weight and conceptual effect of the two elements of WORLDBANK:

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<sup>9</sup> See *Meda Pharma GmbH & Co v OHIM*, Joined cases T-429/09 and T-147/10.

<sup>10</sup> *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07.

“82 Visually and phonetically, the weight of the two elements cited above in the perception of the relevant public is comparable, since the impact of the element „world’ is slightly more pronounced on account of its position at the beginning of the mark applied for. Conceptually, however, in accordance with the rules of English grammar, the element „world’ will be perceived by the relevant consumers, on account of its position at the beginning, as an adjective meaning „global’ and qualifying that element „link’. Thus, the conceptual weight of the element „world’ will be less than that of the element „link’, since the first element is subordinate to the second one. Moreover, on account of its meaning, the element „world’ will be perceived as being descriptive of one aspect of the services covered, since financial services are often provided at a global level, whilst the element „link’ is at most allusive in relation to those services, as was found at paragraph 68 above. It follows that, conceptually, the element „link’ is significantly more important in the overall impression given by the mark applied for. However, its distinctive character is not sufficient to render the other element negligible, which means that it cannot be regarded as the dominant element of that mark.”

29. In the application, TREAT describes the ticket: it qualifies the ticket as being for a treat. So, although it is at the beginning of the mark, it is not the most important element of the mark. The words hang together to create a single phrase which is the idea of a ticket for a treat, reinforced by the devices which resemble the ends of a ticket. The opponent’s case would mean extracting the TREAT element of the applicant’s mark and comparing it with the opponent’s mark, rather than examining the applicant’s mark as a whole. Although in certain circumstances the overall impression of a mark may be dominated by one or more of its components, I do not consider that to be the case here and it is certainly not possible to relegate all other parts of the applicant’s mark to being negligible.

30. For all these reasons, the marks would not be imperfectly recalled, even for identical services. I also need to consider whether, although not directly confused, there is a belief or an expectation upon the part of the average consumer that the services bearing the marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective services come from the same or economically linked undertakings<sup>11</sup>, there is a likelihood of confusion. The opponent submits that the applicant’s mark would be seen as a sub-brand of the opponent because TICKET would be viewed as a sub-brand of TREAT (the opponent’s mark is TREATS). It bolsters this argument by extensive submissions relating to its entitlement to an enhanced distinctive

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<sup>11</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

character through use. However, the opponent has not filed any evidence. I can only consider the inherent distinctive character of TREATS.

31. The opponent submits:

“In assessing the likelihood of confusion in this case the Hearing Officer has to consider notional and fair use of the applied for marks in relation to the services in question as against the rights owned by the Opponent. In this case the assessment must be a relevant consumer knows of and understands the concept of the Opponent’s TREATS trade mark. For example, the use of the Opponent’s TREATS trade mark in relation to a scheme involving the provision of a ticket/coupon against the Applicant’s use of TREATTICKET on the same services. In that context, if the average consumer were to see use of the mark TREATTICKET, in relation to those services, or any other services detailed in the application, then they would assume an association/economic connection with the TREATS trade mark, and therefore a connection with the Opponent.”

32. Mr Iain Purvis QC, sitting as the appointed person in *L.A. Sugar Trade Mark* BL O/375/10<sup>12</sup> explained indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”*

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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<sup>12</sup> All BL-prefixed decisions are available for viewing on the Intellectual Property Office’s website.

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

33. It does not appear to me that TREATS is strikingly distinctive for the services at issue (and I have not limited them to the kind described by the opponent). TREATS is no more than reasonably distinctive. Nor does it appear to me that TICKET falls into category (b) because TREATS is only inherently reasonably distinctive and TICKET does not seem to be to be a non-distinctive element of a kind which one would expect to find in a brand extension. Rather, as explained earlier, TREAT describes the ticket. I cannot see that the applicant’s mark falls into category (c) either. Despite the closeness of the services, on balance, there are more factors pointing away from confusion than towards it. The average consumer will not conclude that the later mark is another brand belonging to the opponent (or vice versa). There is no likelihood of confusion, either directly or indirectly.

#### **Outcome**

**34. The opposition fails. The trade mark application is to proceed to registration.**

#### **Costs**

35. The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I have not made an award for the applicant’s submissions, which consisted of eight lines of text relating to how it and the opponent use their marks (reproduced in paragraph 14 above). This was not evidence, and could not assist its case.

Considering the notice of opposition and filing the counterstatement	£300
<b>Total</b>	<b>£300</b>

36. I order O2 Holdings Limited to pay Treatticket Limited the sum of £300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12th day of March 2013**

**Judi Pike  
For the Registrar,  
the Comptroller-General**

**Annex:** Goods and services of the earlier mark

**Class 09:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; computer software recorded onto CD Rom; SD-Cards; glasses, spectacle glasses, sunglasses, protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes, audio discs; audio-video tapes, audio-video cassettes, audio-video discs; video tapes, video cassettes, video discs; CDs, DVDs; electronic publications (downloadable); mouse mats; magnets; mobile telephone covers, mobile telephone cases; magnetic cards, encoded cards; parts and fittings for all the aforesaid goods.

**Class 35:** Advertising; business management; business administration; office functions; retail services and online retail services relating to scientific, nautical, surveying, photographic, cinematographic, optical weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire extinguishing apparatus, apparatus for the transmission of sound or image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer software, computer software downloadable from the Internet, PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, computer software recorded onto CD-Rom, SD-Cards, glasses, spectacle glasses, sunglasses, protective glasses and cases therefor, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, mobile telephone covers, mobile telephone cases, magnetic cards, encoded cards; information and advisory

services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 36:** Insurance; financial affairs; monetary affairs; real estate affairs; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 37:** Building construction; repair; installation services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 38:** Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database, providing access to computer databases, rental of access time to a computer database; operation of a network, being telecommunication services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 39:** Transport; packaging and storage of goods; travel arrangement; provision of information relating to travel, transport, traffic, traffic flows and congestion; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 41:** Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by

means of telecommunication networks; information services relating to education, training, entertainment, sporting and cultural activities provided by means of telecommunication networks; provision of news information; television production services, television programming services; television production and television programming services provided by means of Internet protocol technology; provision of entertainment by means of television and Internet protocol television; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 42:** Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; IT services; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; computer rental; computer software design; installation of computer software; maintenance of computer software; updating of computer software; rental of computer software; rental of computer hardware; computer system design; computer systems analysis; consultancy in the field of computer software; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); services of engineers; technical consulting and expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment for telecommunications; services of information brokers and providers, namely product research for others; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the field of telecommunications; technical support services relating to telecommunications and apparatus; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 43:** Services for providing food and drink; temporary accommodation; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 44:** Medical services; veterinary services: hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services;

information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.

**Class 45:** Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals; legal services; management and exploitation of copyright; arbitration services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services in relation to the aforesaid services provided over a telecommunications network.